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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPELLANT : JOSEPH E. PORCELLI  
SERIAL NO. : 09/356,771  
FILED : JULY 16, 1999  
TITLE : CAR AND TRUCK BEVERAGE HOLDER  
EXAMINER : BRADLEY DUCKWORTH  
ART UNIT NO. : 3632

**APPEAL BRIEF**

Further to the Notice of Appeal filed on January 11, 2010, this is an Appeal from the Examiner's final rejection of Claims 18 and 20 - 22 in the Office Action dated August 11, 2009.

## TABLE OF CONTENTS

I.	REAL PARTY IN INTEREST.....	1
II.	RELATED APPEALS AND INTERFERENCES.....	2
III.	STATUS OF CLAIMS.....	3
IV.	STATUS OF AMENDMENTS.....	4
V.	SUMMARY OF CLAIMED SUBJECT MATTER.....	5
VI.	GROUND OF REJECTION TO BE REVIEWED ON APPEAL.....	9
	A. Whether Claims 18 and 20 are unpatentable.....	9
	B. Whether Claim 21 is unpatentable.....	9
	C. Whether Claim 22 is unpatentable.....	9
VII.	ARGUMENTS.....	10
	A. Rejection under 35 U.S.C. 103 over Hartman in view of Jackson, further in view of Bieck.....	10
	1. Claim 18.....	10
	2. Claim 20.....	18
	B. Rejection of Claim 21 under 35 U.S.C. 103 over Miller in view of Jackson, further in view of Bieck.....	18
	C. Rejection of Claim 22 under 35 U.S.C. 103 over Miller in view of Jackson, in view of Bieck and further in view of Pratt.....	21
VIII.	CONCLUSION.....	22
	A. Claims Appendix	
	B. Evidence Appendix	
	C. Related Proceedings Appendix	

**I. REAL PARTY IN INTEREST**

The real party in interest in this appeal is the inventor, Joseph E. Porcelli.

## **II. RELATED APPEALS AND INTERFERENCES**

There are no prior or pending appeals, judicial proceedings or interferences known to the Appellant which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

### **III. STATUS OF CLAIMS**

Claims 1-17, 19 and 23 have been canceled from the application. Claims 18 and 20-22 are the only remaining claims in the application and were finally rejected in the Office Action dated August 11, 2009. A copy of the appealed claims are attached in the CLAIM APPENDIX. The status of the claims on appeal is:

Claims rejected: 18 and 20-22  
Claims cancelled: 1-17, 19 and 23

The rejections of Claims 18 and 20-22 are being appealed.

#### **IV. STATUS OF AMENDMENTS**

An *Amendment in Reply to Office Action Under 37 CFR 1.116* was filed on November 11, 2009, subsequent to the final rejection made in the Office Action dated August 11, 2009. In an *Advisory Action before filing of an Appeal Brief* dated November 19, 2009 the proposed amendments were entered.

## V. SUMMARY OF CLAIMED SUBJECT MATTER

One embodiment of the present invention as claimed in independent Claim 18 is directed to a beverage container holder 10 for round and square beverage containers (Figs. 1-3 and pg. 8, lines 2-3 and 12-13).

### PORCELLI (USPN 09/356,771) FIGS. 1-3

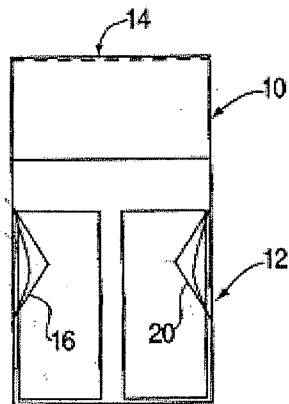


FIG. 1

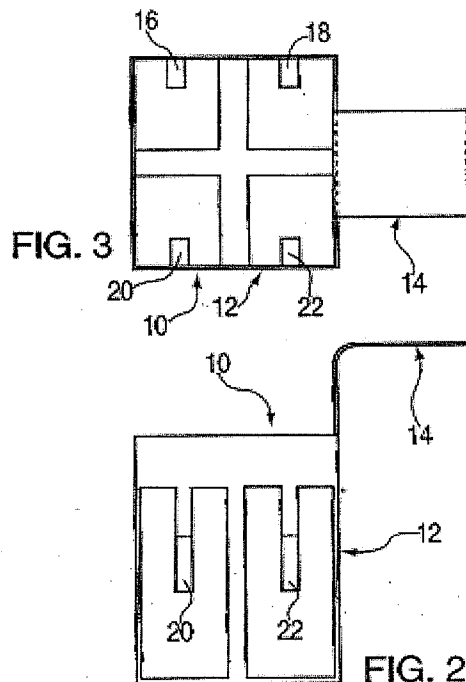


FIG. 2

The beverage container holder 10 comprises a rectangular basket 12 having four side walls each having a top edge border which collectively defines an open top end and which, in turn, defines a rectangular opening (Figs. 1-3, pg. 8, lines 4-5 and original Claims 1 and 3). At least two of said side walls are disposed opposite one another and each have at least one opening therethrough, disposed beneath said top edge border thereof (Figs. 1-3).

The beverage container holder 10 also includes at least four resilient, V-shaped, flat fingers 16, 18, 20 and 22, each having an upper fixed end which is coupled to said top edge border of said rectangular basket and a lower free end extending generally downward into one of said side wall openings of said rectangular basket 12 (Figs. 1-3 and pg. 8, lines 6-10). The fingers 16, 18, 20 and 22 each define a point of a V between said ends thereof and have a V-shaped profile when viewed in a vertical plane with the point of the V extending radially inwardly generally towards the center of the rectangular opening (Fig. 1, pg. 8, lines 6-10 and original Claim 7). The fingers 16, 18, 20 and 22 form a biasing structure for releasably supporting a beverage container when inserted into said rectangular basket 12 and cooperating to resiliently and releasably grasp both round and square beverage containers (pg. 8, lines 10-13).

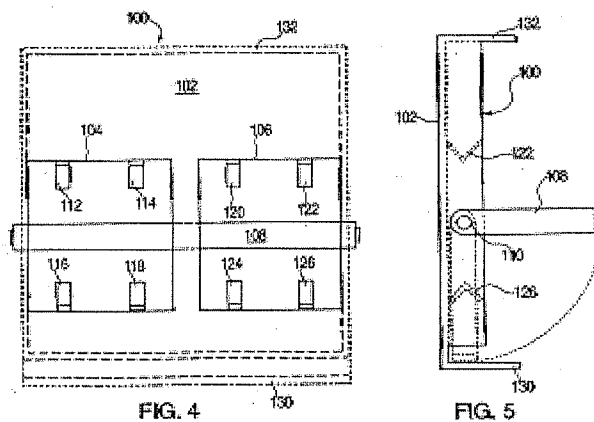
The beverage container 10 further includes a generally U-shaped hook 14 attached to and extending above said basket (See Fig. 2, pg. 8, lines 5-6 and original Claims 2 and 4). The rectangular basket 12, said at least four resilient fingers 16, 18, 20 and 22 and said generally U-shaped hook 14 are formed as a single unitary member (pg. 8, lines 3-6, 17-20 and original Claim 5).

Dependent Claim 20 requires that the singular unitary member is plastic (pg. 8, line 4, 20).



A second embodiment of the present invention as claimed in independent Claim 21 relates to a beverage container holder 100 for round and square beverage containers (Figs. 4-5 and pg. 9, lines 11-14).

**PORCELLI (USPSN 09/356,771)**  
**FIGS. 4-5**



The beverage container holder 100 includes a rectangular tray 102 having a top wall having a pair of spaced-apart rectangular openings 104, 106 (Figs. 4 and 5 and pg. 9, lines 14-16). The beverage container holder 100 also includes at least two sets of four resilient, V-shaped, flat fingers 112, 114, 116, 118, 120, 122, 124 and 126 each having an upper fixed end which is coupled to said top wall of said rectangular tray 102 and a lower free end extending inwardly toward a different one of said rectangular openings 104 and 106 (Fig.4, pg. 10, lines 10-15 and original Claim 16). The fingers 112, 114, 116, 118, 120, 122, 124 and 126 each define a point of a V

between said ends thereof and have a V-shaped profile when viewed in a vertical plane with the point of the V extending radially inwardly generally towards the center of the respective rectangular opening (Fig. 5, pg. 10, lines 10-15 and original Claim 7). The fingers 112, 114, 116, 118, 120, 122, 124 and 126 of each set form a biasing structure for releasably supporting a beverage container when inserted into said rectangular basket and cooperating to resiliently and releasably grasp both round and square beverage containers (pg. 9, lines 10-13).

The beverage container holder 100 also includes a supporting member 108 rotatably coupled to said rectangular tray and being pivotable into a position located below said pair of rectangular openings 104, 106 (Fig. 5, pg. 9, lines 16-21 and pg. 10, lines 1-7).

Dependent Claim 22 requires that the beverage container holder further include spring means 110 for biasing the supporting member 108 to a position located below the rectangular openings 104 and 106 (Fig. 5 and pg. 10, lines 7-10).

**VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL**

A. Whether Claims 18 and 20 are unpatentable under 35 U.S.C. §103(a) over Hartmann et al. (USPN 5,938,160) in view of Jackson (U.S. Design Patent No. D 228,335), and further in view of Bieck et al. (USPN 5,839,711).

B. Whether Claim 21 is unpatentable under 35 U.S.C. §103(a) over Miller et al. (USPN 5,297,767) in view of Jackson, and further in view of Bieck et al.

C. Whether Claim 22 is unpatentable under 35 U.S.C. §103(a) over Miller et al. in view of Jackson, in view of Bieck et al. and further in view of Pratt (USPN 4,530,480).

## **VII. ARGUMENTS**

### **A. Rejection under 35 U.S.C. 103 over Hartmann et al. (USPN 5,938,160) in view of Jackson (USPN D228,335) and further in view of Bieck et al. (USPN 5,839,711)**

#### **1. Claim 18**

It is well known to provide cup holders in motor vehicles to hold various beverage containers. Typically, the cup holders in most vehicles are round structures which are large enough to accept the largest of the most popular bottles, cans and cups (see, spec. pg. 1, lines 8-18). However, these cup holders are all designed to hold round containers (see, spec. pg. 2, lines 1-3) and cannot hold certain common rectangular or square beverages containers (see, spec. pg. 2, lines 4-18).

Thus, at the heart of Appellant's invention is a beverage container holder that can firmly hold both round and square containers having different sizes and shapes (see, pg. 3, line 16-pg. 4, line 9). The beverage container holder of the present application has a configuration and structure which is designed to hold different shaped and sized containers due to the flat, V-shaped fingers which form a biasing structure to releasably support the beverage container which is inserted into the rectangular basket and which cooperate to resiliently and releasably grasp both round and square beverage containers (see, spec. pg. 8, lines 6-13). Neither Hartmann, Jackson nor Bieck alone or in combination discloses or suggests the V-shaped fingers claimed in Claim 18 which resiliently retract to accommodate the variable width and

the contour of a round or square bottle or container to secure it in the holder.

In particular, none of the cited references disclose or suggest the beverage container holder claimed in Claim 18 which includes V-shaped, flat resilient fingers, each of which has an upper fixed end and a lower free end and which define a point of a "V" between said ends thereof which extends radially inward generally towards the center of the respective rectangular opening to form a biasing structure for releasably supporting a beverage container inserted into said basket by cooperating to resiliently and releasably grasp both round and square beverage containers (See Figs. 1-3).

The cited references fail to disclose or suggest some reason why the structure of the present invention would be obvious in light of their teachings.

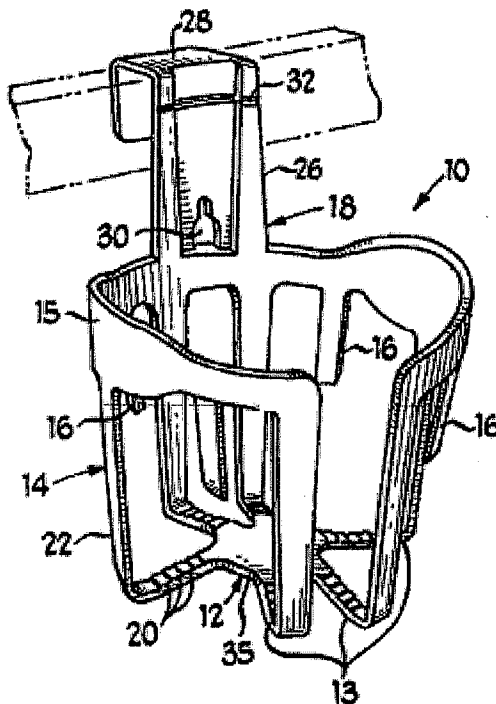
While the Court in *KSR International Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 82 U.S.P.Q.2d 1385 (2007) rejected a rigid application of the teaching, suggestion, or motivation ("TSM") test in an obviousness inquiry, the Court acknowledged the importance of identifying "a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does" in an obviousness determination. *KSR*, 127 S. Ct. at 1731. Moreover, the Court indicated that there is "no necessary inconsistency between the idea underlying the TSM test and the Graham analysis." *Id.* As long as the test is not applied as a "rigid and mandatory" formula, that test can provide "helpful insight" to an obviousness inquiry. *Id.*

*Takeda Chemical Industries Ltd. v. Alphapharm Pty. Ltd.*, 83 USPQ.2d 1169, 1174 (Fed. Cir. 2007) (emphasis added). Even after *KSR*, it remains necessary to identify some reason that would have led one skilled in the art to modify the prior art in a particular manner to establish prima facie obviousness of a new claimed invention. *Id.*

As none of the cited patents disclose or suggest V-shaped, flat resilient fingers which define a point of a "V" between said ends thereof, even in combination the references do not disclose or suggest the features of Claim 18.

Particularly, as admitted in the August 11, 2009 final Office Action, USPN 5,938,160 to Hartmann et al. fails to disclose the basket and opening being rectangular or the use of V-shaped fingers as required by Claim 18 (see, August 11, 2009 Office Action, pg. 3, lines 18-19). As shown in Fig. 1 below, while Hartmann discloses elongated pieces of plastic 16 extending from the cage which support a cup, they are not V-shaped, flat fingers and do not have a point of a "V" between said ends thereof or a V-shaped profile when viewed in a vertical plane. Instead, finger members 16 are flat, elongate and planar fingers (see, Fig. 1 below). While Hartmann discloses modifying the length or width of the fingers 16, it affords no disclosure or suggestion to modify the shape of the fingers (see, col. 2, lines 55-59) and, in fact, neither discloses nor suggests V-shaped fingers having a point of a V between its ends which form a biasing structure for releasably supporting a beverage container, as presently claimed.

HARTMANN ET AL. (USPN 5,938,160)  
FIG. 1



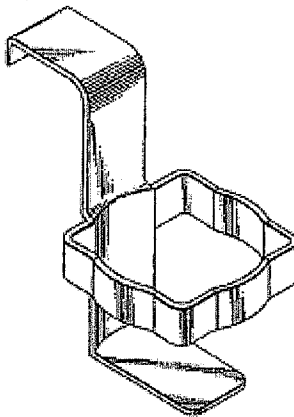
Furthermore, Hartmann does not disclose or suggest the basket and opening being rectangular (see, Figs. 1-7). It is clear from the description and illustrations in Hartmann that the device is intended to be used solely for round cups and does not disclose or suggest use with rectangular beverage containers nor modifying the shape of the basket. In contrast thereto, Claim 18 requires use for both round and square beverage containers and a rectangular basket.

Consequently, there is no reason provided in Hartmann et al. to modify its flat fingers to be V-shaped nor to modify its round basket intended for round beverages to be rectangular, as required by Claim 18.

Furthermore, there is no reason disclosed or suggested in either Hartmann nor Jackson (USPN D228,335) to modify the basket so it is rectangular, as required by Claim 18.

In particular, there is no disclosure in Hartmann or Jackson or any suggestion of the desirability of changing the configuration of the holder from a square to round or round to square configuration. In contrast, Jackson solves the problem of accommodating round and square beverage containers by providing rounded sides of the rectangular frame, and therefore, there is no reason to modify Hartmann in view of Jackson in the manner suggested by the Examiner. Furthermore, as seen in Fig. 1 below, Jackson fails to disclose or suggest any fingers in connection with the beverage holder.

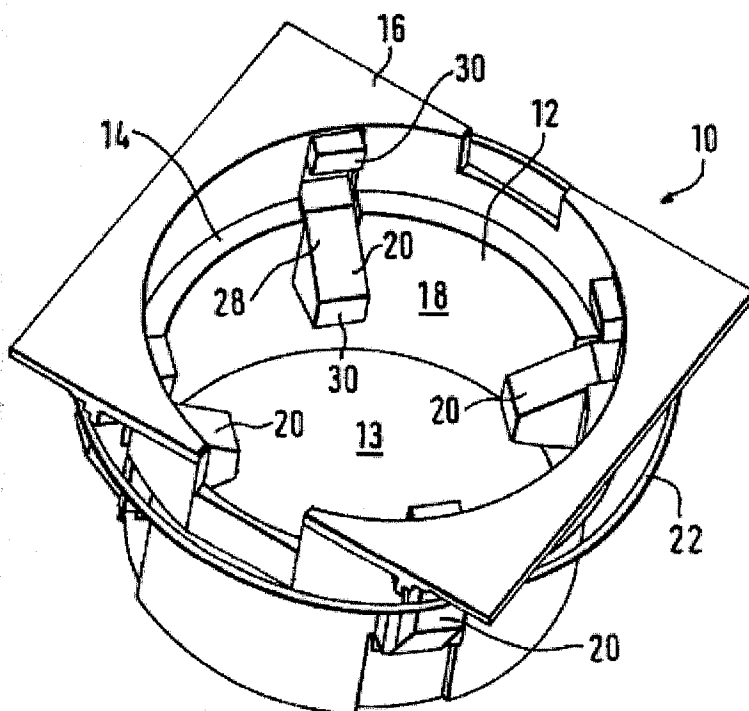
**JACKSON (USPN D228,335)**  
**FIG. 1**





Therefore, it is improper to combine Hartmann with Jackson, unless there is some reason that can be found in the teachings thereof of the desirability of making such combination or of V-shaped fingers, required by Claim 18. This reason is clearly lacking here, causing the asserted combination of Hartmann and Jackson to fail to render Claim 18 obvious.

As mentioned above, both Hartmann and Jackson fail to disclose or suggest the V-shaped, flat fingers each defining a point of a V between said ends thereof, which form a biasing structure to releasably grasp the beverage container. Similarly, USPN 5,839,711 to Bieck et al. fails to disclose or suggest V-shaped, flat fingers which have an upper fixed end and a lower free end extending into a side wall opening, or fingers which define a point of a V between the ends thereof which cooperate to resiliently and releasably grasp both round and square beverage containers, as required by Claim 18. The fingers in Bieck are not flat, do not define a point of a V between their ends, nor do they have an upper fixed end and a lower free end.



Instead, as seen in Fig. 2 above, while Bieck discloses holding jaws 20, they are not flat and are not shaped to define a point of a "V", as required by Claim 18. Each of the solid holding jaws 20 of Bieck has an inclined surface 28 and a flat supporting surface 30. The planar or flat supporting surface 30 is located at secant planes of the container receptacle 12 and are provided for abutting against a circumference of an inserted beverage container (col. 2, lines 46-58). Therefore, the holding jaws of Bieck are not shaped to define a point of a "V", since they have a flat supporting surface 30 which extends towards the inside of the container, and not a point, as claimed in Claim

18. The beverage container inserted in the holder in Bieck is secured by this flat supporting surface 30. There is no reason disclosed or suggested in Hartmann or Bieck to modify the shapes of the fingers in the manner set forth in the Office Action.

Additionally, as seen in Fig. 1, Bieck has locking jaws 20 which are engaged by a ring on the outside of the holder and requires a complex arrangement including a holding jaw 20, spring ring 22, pegs 24, and guides 26. The present invention eliminates the complex structure of Bieck and instead is a simpler, less expensive and easier to manufacture than the beverage holder disclosed in Bieck.

Consequently, Claim 18 requires a beverage holder containing at least four flat resilient fingers being V-shaped to define a point of a "V" between the ends thereof and having a V-shaped profile when viewed in a vertical plane with the point of the "V" extending radially inwardly generally towards the center of the rectangular opening to resiliently and releasably grasp both round and square beverage containers which is not disclosed or suggested in Bieck, Hartmann or Jackson.

It is only through improper hindsight reasoning in light of the Appellant's disclosure that Hartmann, Jackson and Bieck can be combined in the manner suggested in the Office Action in an attempt to reconstruct the claimed invention which is, of course, improper. As noted above, in order for the teachings of these patent references to be properly combined, there must be some reason in the patents themselves which would suggest the desirability of such a combination. The mere fact that the prior art may be modified to produce the claimed invention does not make the

modification obvious unless the prior art suggested the desirability of the modifications. In re Fritch, 23 USPQ.2d 1780 (Fed. Cir. 1992). Such suggestion is clearly lacking here, necessarily causing the asserted combination to fail in rendering Claim 18 obvious.

## **2. Claim 20**

Dependent Claim 20 sets forth that the beverage container holder of Claim 18, be a single unitary member of plastic. In light of the deficiency of the references cited in regard to independent Claim 18 noted above, the rejection of Claim 20 should also fail. The formation of the beverage container holder of the present application as a single unitary member of plastic is a simple and inexpensive way to produce the holder in comparison to the more complex reconstruction of the combination of cited references.

Therefore, it is respectfully submitted that Claims 18 and 20 are patentable over Hartmann, in view of Jackson and further in view of Bieck.

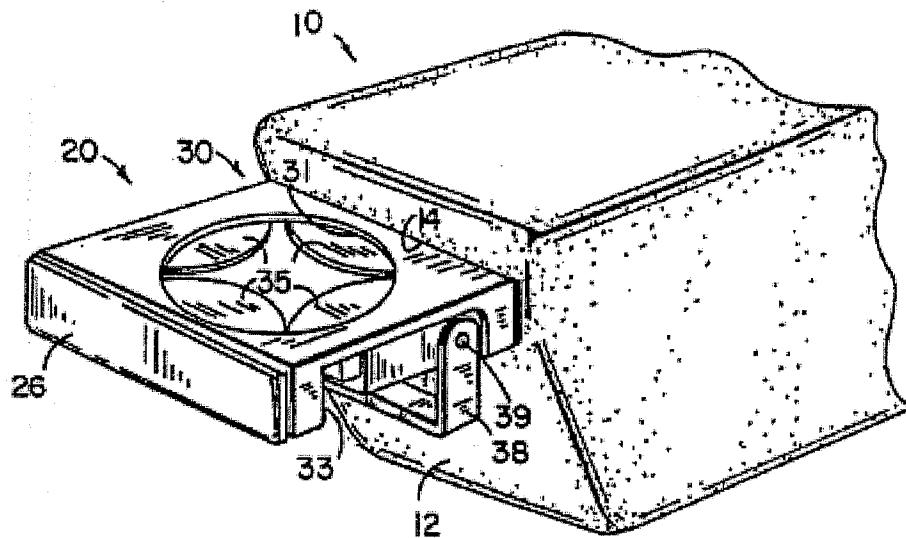
### **B. Rejection of Claim 21 under 35 U.S.C. 103 over Miller et al. (USPN 5,297,767) in view of Jackson (USPN D228,335) further in view of Bieck et al. (USPN 5,839,711)**

A second embodiment of a beverage container holder for round and square beverages is set forth in Claim 21. Like the beverage container holder disclosed above in regard to Claims 18 and 20, here too, Claim 21 requires at least two sets of four

resilient, V-shaped, flat fingers, each having an upper fixed end which is coupled to said top wall of said rectangular tray and a lower free end extending inwardly toward a different one of said rectangular openings, said fingers each defining a point of a V between said ends thereof and having a V-shaped profile when viewed in a vertical plane. However, it would not be obvious to one having ordinary skill in the art to combine Miller with Jackson and Bieck, as like Jackson and Bieck disclosed above Miller also fails to disclose V-shaped, flat finger each defining a point of a "V" between said ends thereof and having a V-shaped profile when viewed in a vertical plane, as required by Claim 21.

In particular, as seen in Fig. 1 below, Miller discloses a beverage container holder for one or two round containers, having four arcuate-shaped resilient discs 35 made of foam. As admitted in the August 11, 2009 Final Office Action, Miller does not teach a rectangular opening or the use of V-shaped resilient members (see, August 11, 2009 Office Action, pg. 4, lines 16-17). Instead in Miller, the discs 35 are not in the shape of a "V" but rather as seen in Fig. 1 below are of a round shape projecting into the inside of the cup holder. There is no reason disclosed or suggested in any of the references to modify the shape of the finger in the manner proposed in the Office Action.

MILLER (USPN 5,297,767)  
FIG. 1



Particularly, it would not have been obvious to combine Miller with Jackson because as mentioned above, Jackson does not disclose or suggest any fingers in connection with its beverage holder and gives no reason to modify the shape of the holder from round to rectangular or vice versa. Furthermore, it would not have been obvious to combine the references with Bieck because as discussed more fully above, Bieck does not disclose or suggest flat, resilient fingers nor fingers which are shaped to define a point of a "V."

Furthermore, in Miller, the beverage holders are not in a side by side relationship as depicted in Fig. 4 of the present invention. Therefore, the beverage holder requires

two separate container support members 38 and 48 (see Fig. 2). In contrast, the present invention places the cup holders side by side and provides for a supporting member 108 which extends beneath both of the openings to receive the beverages. Therefore, the present invention eliminates an extra piece that is required in the Miller patent which makes the construction simpler, less expensive and easier to manufacture.

Therefore, Miller, Jackson and Bieck in combination fail to disclose or suggest Claim 21 as none of the references disclose or suggest V-shaped fingers defining a point of a V and it is respectfully submitted that Claim 21 is patentable over these references.

**C. Rejection of Claim 22 under 35 U.S.C. 103 over Miller (USPN 5,297,767) in view of Jackson (USPN D228,335), in view of Bieck et al. (USPN 5,839,711) and further in view of Pratt (USPN 4,530,480)**

Dependent Claim 22 sets forth that the beverage container holder of Claim 21 further comprises spring means for biasing said supporting member to said position located below said rectangular opening. Pratt discloses a round cup holder and fails to correct the crucial deficiencies noted above as it does not have V-shaped fingers to engage the beverage container. Therefore, in light of the deficiency of the references cited in regard to independent Claim 21 discussed above, the rejection of Claim 22 should also fail. Therefore, it is respectfully submitted that Claim 22 is patentable over Miller in view of Jackson, in view of Bieck and further in view of Pratt.

### VIII. CONCLUSION

By reason of the foregoing, it is respectfully submitted that the claims on appeal (i.e., Claim 18, and 20-22) are patentably distinguishable over the art cited. Accordingly, the Board is earnestly urged to reverse the Examiner and to sanction issuance of a patent to Appellant.

Respectfully submitted,

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Enclosures: Appendices A-C

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**A. CLAIMS APPENDIX**

Claim 18. A beverage container holder for round and square beverage containers, comprising:

a rectangular basket having four side walls, each having a top edge border which collectively define an open top end and which, in turn, defines a rectangular opening, at least two of said side walls disposed opposite one another each having at least one opening therethrough disposed beneath said top edge border thereof; and

at least four resilient, V-shaped, flat fingers, each having an upper fixed end which is coupled to said top edge border of said rectangular basket and a lower free end extending generally downward into one of said side wall openings of said rectangular basket, said fingers each defining a point of a V between said ends thereof and having a V-shaped profile when viewed in a vertical plane with the point of the V extending radially inwardly generally towards the center of the rectangular opening, said fingers forming a biasing structure for releasably supporting a beverage container when inserted into said rectangular basket and cooperating to resiliently and releasably grasp both round and square beverage containers; and

a generally V-shaped hook attached to and extending above said basket, wherein

said rectangular basket, said at least four resilient fingers and said generally V-shaped hook are formed as a single unitary member.

Claim 20. A beverage container holder according to Claim 18, wherein said single unitary member is plastic.

Claim 21. A beverage container holder for round and square beverage containers, comprising:

a rectangular tray having a top wall having a pair of spaced-apart rectangular openings; and

at least two sets of four resilient, V-shaped, flat fingers, each having an upper fixed end which is coupled to said top wall of said rectangular tray and a lower free end extending inwardly toward a different one of said rectangular openings, said fingers each defining a point of a V between said ends thereof and having a V-shaped profile when viewed in a vertical plane with the point of the V extending radially inwardly generally towards the center of the respective rectangular opening, said fingers of each set forming a biasing structure for releasably supporting a beverage container when inserted into said rectangular basket and cooperating to resiliently and releasably grasp both round and square beverage containers; and

a supporting member rotatably coupled to said rectangular tray and being pivotable into a position located below said pair of rectangular openings.

Claim 22. A beverage container holder according to Claim 21, further comprising:

spring means for biasing said supporting member to said position located below said rectangular opening.

**B. EVIDENCE APPENDIX**

None

**C. RELATED PROCEEDINGS APPENDIX**

None